

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration of this application in view of the present amendments and the following remarks. By this amendment, claims 1, 6, 14, 18, 24 and 28 are amended. As a result, upon entry of this amendment claims 1-30 are pending and at issue in this case, with claims 1, 2, 8, 14, 21, 24 and 28 being independent claims. It is believed that no additional fees are due for the consideration of this paper. However, if additional fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

Amendments to the Claims

It is respectfully submitted that the claims as amended above are supported by the application as originally filed in the Patent Office on July 31, 2001, that the amended claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. Claims 1, 6, 14, 18, 24 and 28 are amended to more clearly recite that the mechanisms or means recited therein as providing a resistant force on the movement of a cord in one direction do not provide a resistant force to the movement of the cord in the opposite direction. The amendments to claims 1, 6, 14, 18, 24 and 28 are supported by the application as originally filed at least at FIGS. 4 and 5 and at page 11, lines 25-30, which describe a one-way tensioning mechanism 24 coupled to cord 30 and configured to have a stop position when the cord 30 moves in one direction (FIG. 5) and a free-wheeling position when the cord 30 moves in the opposite direction (FIG. 4). Therefore, Applicant respectfully submits that the amendments to claims 1, 6, 14, 18, 24 and 28 do not present new matter and do not raise new issues, and respectfully requests entry of the present amendments to claims 1, 6, 14, 18, 24 and 28 and consideration of the claims as amended.

Response to Claim Rejections

The Examiner has indicated in the Office action that claims 2-5, 8-13 and 21-23 are allowed. Claims 14, 19 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Kuhar (U.S. Patent No. 5,482,100), claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhar '100, and claims 1, 6, 7, 15-17 and 24-30 were rejected under

§103(a) as being unpatentable over Kuhar '100 in view of Carouso (U.S. Patent No. 1,863,620). Applicant respectfully traverses these rejections.

Regarding the rejections of claims 14, 19 and 20 under §102(b) and claim 18 under §103(a), as discussed above, claims 14 and 18 are amended to recite cordless blinds wherein the means for providing resistant forces on movement of the cords in one direction does not provide resistant forces on movement of the cords in the opposite direction. Applicant respectfully submits that claims 14 and 18 as amended exclude means that provide resistant forces on cords in both directions, such as the slots 56 of the Kuhar '100 patent. Kuhar '100 teaches slots 56 that may be used to increase the tension of the cord 52 traveling through portion 47 toward cord spool 30. Kuhar '100, col. 4, lines 51-54. The slots 56, which are illustrated in Fig. 2 of the Kuhar '100 patent, are stationary and appear to apply a resistant force as the cord 52 is pulled away from the cord spool 30, thereby providing resistant force on the movement of cord 52 in both directions. Further, the Kuhar '100 patent does not suggest that either the slots 56 or any other structure may be used to provide resistant force in only one direction. Therefore, because the Kuhar '100 patent cited in the Office action does not disclose or suggest a means for providing a resistant force on movement of cords in only one direction as recited in claim 14, it follows that the Kuhar '100 patent neither anticipates nor renders obvious amended independent claim 14 and claims 18-20 depending there from.

Regarding claims 1, 6, 7, 15-17 and 24-30, Applicant respectfully reasserts that there is no suggestion or motivation for combining the Kuhar and Carouso references in the manner proposed by the Examiner. The prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Merely stating integration of the claimed elements is obvious is *not* the same as “show[ing] a motivation to combine the references.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Therefore, an examiner may often find every element of a claimed invention in the prior art. *If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.* Furthermore, rejecting patents solely by finding prior art

corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references* that create the case of obviousness.

Id. at 1457 (citations omitted and emphasis added).

Simply arguing that the cited prior art references relate to the same field of endeavor is not sufficient to meet the suggestion requirement. In the *Rouffet* decision, “the parties agree[d] that the five references asserted by the examiner were in the same field of endeavor as the invention,” but the rejections were still held to be improper for failing to identify a proper suggestion for combining the cited art. *Id.* at 1456. In order to establish a *prima facie* case of obviousness, there must be *actual evidence* of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be *clear and particular*. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to modify the prior art must be made. *See, e.g., Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and *Dembiczak*, 50 U.S.P.Q.2d at 1617-1618, where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, *particular factual findings* regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal.

The law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court . . . foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, *Ex parte Megens*, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 U.S.P.Q. 173, 177-78 (C.C.P.A. 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

(*Megens* at Page 4).

Furthermore, the mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the *prior art* also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)” (emphasis original). The suggestion to combine references must be from the *prior art*, not the Applicant's disclosure. See Section 2143 of the M.P.E.P., which states: “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the *prior art*, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).” (emphasis added).

Applicant respectfully resubmits that the Kuhar and Carouso references are neither analogous art, as admitted by the Examiner, nor in the same field of endeavor. Kuhar relates to cordless blinds wherein a constant variable spring motor is adapted to balance the blinds by providing a variable force that is “at its highest level when the blind or shade is fully raised, i.e., when the cords are supporting the full weight of the window covering [and] at its lowest point when the window covering is fully lowered and, in the case of blinds, the slats are being individually supported by ladders, rather than by the cords, leaving only the bottom bar to be supported by the cord.” Kuhar, Abstract and col. 2, lines 40-50. Carousso, conversely, does not relate to using a spring motor to balance a varying weight or to prevent “creep.” Instead, Carousso provides springs 30 that, by design, at all times exert forces

sufficient to overcome the weight of the cords 17 and supported heaters 34, and to rewind the cords 17 onto reels 19, 20. Carouso, in fact, teaches away from balancing by providing dogs 31 in discs 28 engaging detents 32 of the pulleys 25 to prevent the pulleys 25 from rotating by the urging of the springs 30 actuating the reel and tending to rewind the cord cords 17 on the reels 19, 20. Carouson, page 2, lines 5-24. Therefore, Kuhar (balancing a varying amount of weight) and Carouson (providing a locking mechanism to prevent rewinding by a spring designed to always supply sufficient force to overcome a suspended weight) do not relate to the same field of endeavor.

Even if we assume that Kuhar and Carouson relate to the same field of endeavor, Applicant respectfully submits that the Examiner has provided no factual basis for a suggestion or motivation to combine the references. Stating that one of ordinary skill in the art experiencing problems with counterbalanced blinds having spring motors that are out of balance would look to Carouson is conclusory and impermissibly uses the Applicant's own disclosure to create the motivation to combine the references, which constitutes an improper hindsight analysis. Further, the Examiner's statements that the pulleys 25 of Carouson are "more efficient" or "an obvious expedient" to structures in Kuhar are unsupported by any facts whatsoever. Even if true, which, depending on the factors relevant to determining which of two alternatives is "more efficient" or "an obvious expedient" may lead to different conclusions, the Examiner has cited no support for the proposition that substituting a more efficient or obviously expedient alternative for a disclosed alternative constitutes sufficient motivation or suggestion for the combination. As previously stated, the mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. For these additional reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness of claims 1, 6, 7, 15-17 and 24-30, and that the rejection based on the combination of the Kuhar and Carouson references should not be extended to amended claim 14 and claims 18-20 depending therefrom. Therefore, Applicant respectfully requests an indication of allowance of these claims.

Entry and consideration of the foregoing amendments as improving the form of the application are solicited. The amendments have the effect of narrowing the issues for consideration by Examiner Johnson, or on appeal, and were not earlier presented because, prior to the final Office action and Examiner Johnson's comments therewith, these amendments were not felt necessary to obtain allowance.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

By


Scott E. Baxendale
Registration No. 41,605
Attorney for Applicant
Marshall, Gerstein & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300

May 16, 2003